

Application No. 09/967,232  
Amendment dated June 18, 2007  
Reply to Office Action of March 29, 2007

Docket No.: 47171-00305USP1

### REMARKS

Claims 1-6, 11-89 are pending in the patent application. Claims 7, 13, 14, 16, 21, 30-32, 34, 37, 41-48, 57, 58, 60-64, 66, 67, 71-78, 81-86, and 88 are withdrawn. Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected in the office action mailed on March 29, 2007. Claims 1, 11, 18, 20, 27-28, 49, 87, and 89 have been amended.

### Claim Objections

Claim 87 was objected to because of an informality. Claim 87 has been amended to correct the informality.

### 35 U.S.C. § 103 Rejection

In the final Office Action dated March 29, 2007, the rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 based on 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Publication No. 61-14557 ("Hatanaka"), in view of United Kingdom Patent Application No. GB 2088832A ("Fujii"), and further in view of U.S. Patent No. 5,394,992 ("Winkler"), and U.S. Patent No. 5,761,089 ("McInerny") was maintained.

As pointed out in the Applicant's prior response, one basic requirement for a *prima facie* case of obviousness is that the prior art references must teach or suggest all of the claim limitations. M.P.E.P. § 2143. Hatanaka in view of Fujii and further in view of Winkler and McInerny does not satisfy this test. All of the currently rejected independent claims are directed to devices and/or systems which process both currency bills and a second type of document. See claim 1 ("currency bills and substitute funds"); claim 11 ("currency bills and substitute currency media"); claim 56 ("currency bills and barcoded media"); claim 79 ("currency bills of mixed denominations and barcoded media"); claim 87 ("currency bills and substitute currency media, the substitute currency media being redeemable documents"); and claim 89 ("currency bills and redeemable documents"). However, it is undisputed that Hatanaka, Fujii, Winkler, and McInerny are directed to devices for processing paper currency and that these references do not teach or suggest devices which are adapted to process substitute funds, substitute currency media, barcoded media, or redeemable documents, let alone devices which are adapted to

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process any of these types of documents and also currency bills. Accordingly, a *prima facie* case of obviousness has not been established. Thus, the rejection must be withdrawn.

Claim 1 of the present application recite several limitations, among them "a processing module coupled to the input receptacle and adapted to process the currency bills and substitute funds."

Claim 11 recites "an evaluation unit comprising at least one currency detector disposed along the transport path between the input receptacle and the output receptacle, the at least one currency detector being capable of evaluating currency bills, and a first media detector disposed along the transport path between the input receptacle and the output receptacle, the first media detector being capable of evaluating substitute currency media."

Claim 56 recites "an evaluation unit including a first sensor disposed along the transport path between the input receptacle and the output receptacle, the first sensor being adapted to detect at least one characteristic of a currency bill, and a first barcode reader disposed along the transport path between the input receptacle and the output receptacle, the barcode reader being adapted to scan a barcode."

Claim 79 recites "an evaluation unit disposed along the transport path between the input receptacle and the plurality of output receptacles, the evaluation unit comprising at least one currency sensor and a barcode reader positioned adjacent the transport path, the at least one currency sensor being adapted to obtain denomination characteristic information of a first currency bill, the barcode reader being adapted to scan for a barcode on a document from the stack of documents passing along the transport path, a document on which the barcode reader detects a barcode being termed a valid barcoded medium, a document on which the barcode reader does not detect a barcode being termed an invalid barcoded medium."

Claim 87 recites "an evaluation unit comprising a first scanner disposed along the transport path between the input receptacle and the output receptacle, the first scanner being capable of scanning for at least one characteristic associated with a currency bill, the evaluation unit further comprising a second scanner capable of scanning for at least one characteristic associated with a substitute currency medium."

Claim 89 recites "an evaluation unit comprising a detector disposed along the transport path between the input receptacle and the output receptacle, the detector being adapted

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to detect characteristic information associated with a currency bill and characteristic information associated with a redeemable document."

There is no teaching or suggestion within Hatanaka of any documents other than currency notes being evaluated. Rather, Hatanaka discloses a device that may identify and count "notes of paper currency." p. 3, ll. 1-4. In fact, the entire disclosure of Hatanaka is directed to currency notes, and no reference is ever made to any other type of media that may be processed by Hatanaka.

Fujii also only discloses a device that is only adapted to evaluate currency notes. Fujii teaches that a reason for rejecting a note may be stored in a memory, however, Fujii in no way teaches or suggests the ability to process substitute funds, substitute currency media, barcoded media, or redeemable documents.

Similarly, both McInerny and Winkler are directed to processing currency bills, and do not disclose or suggest the ability to process substitute funds, substitute currency media, barcoded media, or redeemable documents.

Therefore, there is no teaching or suggestion within the cited references of the capability of processing both (a) currency bills and (b) any of substitute funds, substitute currency media, barcoded media, or redeemable documents.

In response to the recognition of the failure of the cited references to teach or suggest a device adapted to process substitute funds, substitute currency media, barcoded media, or redeemable documents, the Office Action merely contains the unfounded and conclusory statement that "substitute funds," "casino script," "paper tokens," "gift certificates," "retailer coupons," and "bar coded tickets" "are all considered functional equivalents of each other and that it would have been obvious to one ordinarily skilled in the art to have set Hatanaka's device to discriminate these various forms of currency and segregate them accordingly." However, Hatanaka, Fujii, Winkler, and/or McInerny, singularly and collectively, fail to disclose the recitations of the pending claims regarding substitute funds, substitute currency media, barcoded media, or redeemable documents. Therefore, the Examiner has failed to show that the prior art references relied upon teach or suggest all of the recited limitations, and thus, a *prima facie* case of obviousness has not been shown. Furthermore, no reference has been relied upon in rejecting the present claims which teaches or suggests (1) that "substitute funds," "casino script," "paper tokens," "gift certificates," "retailer coupons," and "bar coded tickets" "are all considered

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functional equivalents of each other” or (2) that the currency device of Hatanaka should be modified to be able to process any of these types of documents in addition to currency bills or (3) that the currency device of Hatanaka should be modified to be able to process any of these types of documents in addition to currency bills and further be modified to segregate these types of documents “accordingly,” whatever that means.

In addition to the previous reasons the relied upon references fail to make *prima facie* case of obviousness, with regards to independent claims 11, 56, 79, 87, the Examiner has failed to cite a teaching within these references that disclose a “media detector,” a “barcode reader,” or a “second scanner capable of scanning for at least one characteristic associated with a substitute currency medium” in addition to a separate detector, sensor, or scanner used to process currency as recited in these claims.

On page 10 of the Office Action, it is stated with respect to claims 13 and 79 that a “barcode reader is an optical detector/scanner.” First, it is noted that claim 13 stands withdrawn. Perhaps, the Examiner meant to refer to claim 11 instead of claim 13. Second, Applicants do not understand the relevance of this statement and respectfully request clarification.

On page 10, the Office Action alleges that McInerny discloses several detectors (80) which sense optical characteristics of bills and bill substitutes, optical sensors (82,84) which are used to detect opacity in documents, and a magnetic sensor (86) that detects magnetic characteristic of bills and bill substitutes. First, Applicants do not understand the point the Examiner is trying to make by mentioning the purported teaching in McInerny as to opacity detection and magnetic sensors. It is noted that the USPTO has already determined that different types of sensors in the context of the present application are patentably distinct. See the restriction/election requirements in Office Actions dated December 8, 2004 and April 7, 2005 as clarified during an interview on May 8, 2006 (discussed further below in the section addressing the outstanding obviousness-type double patenting rejections) and patentably distinct claims 40-48. Secondly, Applicants traverse the assertion that McInerny teaches “bill substitutes” and respectfully requests the Examiner to clarify where McInerny teaches “bill substitutes” and what that term means in the context of McInerny. Applicants maintain that McInerny contains no such teaching.

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On page 11, the Office Action states "McInerny's optical sensor (80) can be construed as "a bar code reader" since it has the structure of an optical scanner, which is the same structure a bar code reader has." On page 14, the Office Action states:

Applicant asserts that a bar code reader is different than an optical scanner for bills. However, the physical structure required by the apparatus claim structure recited can only be differentiated based on structure, not functional language. An optical scanner has the same basic features as bar code reader-an optical light source that illuminates the target, the resulting image being sampled by the optical light source. Regardless of whether the target is a bill or bar code or coupon or voucher or other such currency substitute, the optical scanner works the same.

These assertions are respectfully traversed and perplex the Applicants. It is readily apparent in reviewing McInerny that McInerny does not disclose a barcode reader and that sensor 80 of McInerny is not a barcode reader. There can be no dispute that sensor 80 of McInerny does not read barcodes.

The Office Action appears to be saying that any structure which detects light is a barcode reader. Applicants respectfully submit that such an assertion does not make sense and that those skilled in the art would not share such opinion. The Hubble telescope detects light but no one skilled in the art would maintain that the Hubble telescope is a barcode reader. Likewise, there is no basis to allege that those skilled in the art would understand that all devices which illuminate a target and detect light are bar code readers. The Office Action fails to cite any authority supporting these arguments.

Barcode readers are well known in the art and "barcode reader" has a well understood meaning, facts which have not been disputed by the Examiner. That is all that is necessary under the law and the Examiner may not ignore the limitations of a barcode reader in claims 33, 35, 36, 56, 59, 65, 68-70, and 79-80. See *Personalized Media Communications, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 704-705 (Fed. Cir. 1998) which held that the term "detector" recited sufficient structure, the court stating:

neither the fact that a "detector" is defined in terms of its function, nor the fact that the term "detector" does not connote a precise physical structure in the minds of those skilled in the art detracts from the definiteness of structure. Even though the term "detector" does not specifically evoke a particular structure, it does convey to one knowledgeable in the art a variety of structures known as "detectors."

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Internal citations omitted. See also *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed. Cir. 1996) in which the term “detent mechanism” was found to be acceptable, the court noting “[m]any devices takes their names from the functions they perform...such as ‘filter,’ ‘brake,’ ‘clamp,’ ‘screwdriver,’ ‘lock’” and the court also stating:

It is true that the term “detent” does not call to mind a single well-defined structure, but the same could be said of other commonplace structural terms such as “clamp” or “container.” What is important is not simply that a “detent” or “detent mechanism” is defined in terms of what it does, but that the term, as the name for structure, has a reasonably well understood meaning in the art.

*Id.*

The Applicants also traverse the assertion that an “apparatus claim structure recited can only be differentiated based on structure, not functional language.” Such an assertion is inconsistent with Federal Circuit law. See *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997) (“A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 58 C.C.P.A. 1027, 439 F.2d 210, 212, 169 U.S.P.Q. (BNA) 226, 228 (CCPA 1971) (“There is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”)). Furthermore, it is also noted that the Examiner is not free to disregard claim language while assessing patentability. *Application of Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494 (CCPA 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”); *In re Lowry*, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994) (“The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art.”); MPEP §§706.02(j); 2142; 2143.03.

Accordingly, a *prima facie* case of obviousness has not been established and all the pending claims should be allowed. Additionally, the recitation of a barcode reader present in some of the pending claims can not be ignored or rewritten to instead recite an “optical scanner.” Accordingly, at least claims 27-28, 33, 35-36, 49-56, 59, 65, 68-70, 79-80 are allowable for the additional reason that they recite a “media detector is adapted to read a barcode” or a “barcode reader,” neither of which is disclosed in Hatanaka, Fujii, Winkler, or McInerny, and thus, a *prima facie* case of obviousness has not been established.

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**New Ground of Rejection**

In the outstanding Final Office Action, the Examiner for the first time cites to MPEP 2115 for the proposition that "the material or article worked upon does not limit apparatus claims." Applicant's respectfully traverse this rejection and the making of such a rejection for the first time in a Final Office Action. Applicants also maintain that such an objection to the pending apparatus claims is inconsistent with the prior restriction out of the methods claims which were originally contained in the present application. The presentation of such a new argument in a final office action after restricting out the method claims from the present application and at such time when the final nature of the Office Action restricts the Applicant's ability to amend the claims and/or submit new claims, unjustly inhibits Applicant's ability to fairly respond. Accordingly, at a minimum, it is respectfully requested that the Final status of the present rejections be withdrawn and Applicant's be afforded an opportunity to freely amend the claims and/or submit new claims in response to this new ground of rejection.

Additionally, it is maintained that MPEP 2115 may not be relied upon to disregard claim language present in the rejected claims. *Application of Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art."); *In re Lowry*, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994) ("The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art."); MPEP §§706.02(j); 2142; 2143.03.

Finally amended claim 1 recites, *inter alia*, "the processing module being configured to distinguish currency bills from substitute funds and valid substitute funds from invalid substitute funds," amended claims 11 and 87 recite, *inter alia*, "the evaluating unit being configured to distinguish currency bills from substitute currency media and to distinguish valid substitute currency media from invalid substitute currency media," and amended claim 89 recites, *inter alia*, "the evaluating unit being configured to distinguish currency bills from redeemable documents and to distinguish valid redeemable documents from invalid redeemable documents." These limitations are neither taught or suggested by Hatanaka, Fujii, Winkler, or McInerny; and thus, claims 1-6, 11-12, 15, 17-20, 22-29, 33, 35-36, 38-40, 49-55, 87, and 89 are allowable for these additional reasons.

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### **Double Patenting Rejections**

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-73 of U.S. Patent No. 6,880,692, claims 1-78 of U.S. Patent No. 6,913,130, claims 1-91 of U.S. Patent No. 6,959,800, claims 1-31 of U.S. Patent No. 6,955,253, or claims 1-26 of U.S. Patent No. 6,868,954.

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-29, 78-89, and 146-149 of copending Application No. 09/684,103.

The terminal disclaimers filed on 12/26/06 were not accepted. These terminal disclaimers are rescinded, revoked, and otherwise withdrawn. Instead, Applicants respectfully traverse these rejections and respectfully request the withdrawal of such rejections because the claims of each of the cited patents/application have elements that are not present in any of the rejected claims of the present application and/or vice versa.

To begin with, in making the above rejections, the Examiner states: "Although not all of the claims may have been recited an 'optical scanning head', it is considered to be obvious to have included such a device because the apparatus claimed is designed to operate with such a pattern detection unit, and would not work without such a device." This statement is respectfully traversed at least because Applicants do not understand this statement. Furthermore, it is not clear how this statement relates to any of the rejected claims and/or the claims in the cited other patents/application. Furthermore, this statement includes words and expressions that are not found in the presently rejected claims and is thus traversed. It is noted that the presently rejected claims are limited only by the actual words in those claims.

An obviousness-type double patenting rejection involves comparing the claims of the present application to that of a second application or patent. In the present application, a number of claims have already been determined to be patentably distinct from the currently rejected claims. In the Office Action dated December 8, 2004, the system and method claims of the present application were found to be patentably distinct. It is submitted that the claims of the other patents and application cited in the present obviousness-type double patenting rejections are at least as different from the presently rejected claims as the patentably distinct method



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claims of the present application are different from those same presently rejected claims. Accordingly, the obviousness-type double patenting rejections are improper and should be withdrawn.

Likewise in the Office Action dated December 8, 2004, it was found that the present application contained patentably distinct apparatus species including elected Species I directed to a processing device with a plurality of output receptacles; Species II directed to a single out processing device; Species III directed to a dual output receptacle processing device; Species IV directed to a processing device with coin sorting; and Species V directed to a processing device attached to a network. Additionally a further restriction/election requirement was issued in the Office Action dated April 7, 2005. As clarified during an interview on May 8, 2006, a number of dependent claims were held to be patentably distinct from the presently rejected claims including, *inter alia*: claim 14 which recites:

the controller causes the transport mechanism to halt in response to the detection of a particular currency bill or substitute currency medium that meets or fails to meet one or more criteria, wherein the halting causes the particular currency bill or substitute currency medium to be located at a predetermined position

and claim 41 reciting a "magnetic sensor"; claim 42 reciting a "size detection sensor"; claim 43 reciting a "density sensor"; claim 44 reciting a "thread sensor"; claim 45 reciting an "infrared sensor"; claim 46 reciting an "ultraviolet scan head"; claim 47 reciting a fluorescent light scan head"; claim 48 reciting a "full image scanner"; claim 71 reciting the "system of claim 56 further comprising a second barcode reader coupled to the controller, the first barcode reader and the second barcode reader being disposed on opposite sides of the transport path"; claim 81 reciting the "apparatus of claim 80, wherein the controller is adapted to direct no call bills to a specified third output receptacle of the plurality of output receptacles"; claim 82 reciting the "apparatus of claim 80, wherein the controller is adapted to direct suspect bills to a specified third output receptacle of the plurality of output receptacles"; claim 83 reciting the "apparatus of claim 80, wherein the controller is adapted to direct no call bills to a specified third output receptacle of the plurality of output receptacles and to direct suspect bills to a specified fourth output receptacle of the plurality of output receptacles"; claim 84 reciting the "apparatus of claim 80, wherein the controller is adapted to direct no call bills and suspect bills to a specified third output receptacle"; claim 85 reciting the "apparatus of claim 80, wherein the controller is adapted to direct invalid barcoded media to a specified third output receptacle"; and claim 88

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reciting, in part, "an interface coupled to the controller, the interface being adapted to receive instructions from an operator of the apparatus specifying one or more of the plurality of output receptacles to which currency bills and substitute currency media are to be directed." As will be discussed below, some of the claims in the cited other patents/application recite limitations similar to some of these patentably distinct limitations; and thus, the claims of the cited other patents/applications are patentably distinct from the rejected claims and the obviousness-type double patenting rejections are improper and should be withdrawn.

[1] Turning to U.S. Patent No. 6,880,692, the claims of this patent differ from the rejected claims of the present application. To begin with, all of the claims of this patent are method claims; and thus, the rejection is improper given the finding that the method claims of the present application are patentably distinct from the rejected apparatus/system claims. Furthermore, claim 1 of U.S. Patent No. 6,880,692 recites several elements that are not recited in the presently rejected claims such as

- transporting the bills, one at a time, from the input receptacle to one of exactly two output receptacles of the currency evaluation device ...

- determining whether the bills meet or fail to meet a non-piece count related criterion; and

- halting the transporting when a bill meets or fails to meet the criterion, a bill meeting or failing to meet the criterion being termed a flagged bill,

- wherein the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles,

- wherein bills whose denomination are determined are delivered to a first output receptacle and wherein bills whose denomination are not determined are directed to a second output receptacle, a bill whose denomination is not determined being termed a no call bill.

Compare to, for example, withdrawn patentably distinct claims 31 and 76 and 14 and 81-86 of the present application. The other independents of U.S. Patent No. 6,880,692 appear to recite some of the same elements such as "exactly two output receptacles" and halting or stopping that are not recited in the presently rejected claims. The rejected claims of the present application also have elements that are not present in the claims of U.S. Patent No. 6,880,692 such as "substitute funds" in independent claim 1, "substitute currency media" in independent claim 11, "barcoded media" and "barcode reader" in independent claims 56 and 79, "substitute currency

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media," "redeemable documents," and "a second scanner capable of scanning for at least one characteristic associated with a substitute currency medium" in independent claim 87, and "redeemable documents" and "a detector ...adapted to detect ... characteristic information associated with a redeemable document" in independent claim 89.

[2] Turning to U.S. Patent No. 6,913,130, the claims of this patent differ from the rejected claims of the present application. For example, claim 1 of U.S. Patent No. 6,913,130 recites several elements that are not recited in the presently rejected claims such as

exactly two output receptacles adapted to receive the bills after the bills have been evaluated ...

a processor programmed to determine whether the bills meet or fail to meet a non-piece count related criterion, the processor being programmed to cause the transport mechanism to halt in response to a determination that a bill meets or fails to meet the criterion, a bill meeting or failing to meet the criterion being termed a flagged bill, the processor being adapted to cause the transport mechanism to halt with a flagged bill being positioned as the last bill in one of the output receptacles; and

wherein bills whose denomination are determined by the discriminating unit are delivered to a first output receptacle and wherein bills whose denominations are not determined by the discriminating unit are directed to the other output receptacle, bills whose denomination are not determined by the discriminating unit being termed no call bills.

Compare to, for example, withdrawn patentably distinct claims 31 and 76 and 14 and 81-86 of the present application. The other independents of U.S. Patent No. 6,913,130 appear to recite some of the same elements such as "exactly two output receptacles" and halting or stopping that are not recited in the presently rejected claims. The rejected claims of the present application also have elements that are not present in the claims of U.S. Patent No. 6,913,130 such as "substitute funds" in independent claim 1, "substitute currency media" in independent claim 11, "barcoded media" and "barcode reader" in independent claims 56 and 79, "substitute currency media," "redeemable documents," and "a second scanner capable of scanning for at least one characteristic associated with a substitute currency medium" in independent claim 87, and "redeemable documents" and "a detector ...adapted to detect ... characteristic information associated with a redeemable document" in independent claim 89.

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[3] Turning to U.S. Patent No. 6,959,800, the claims of this patent differ from the rejected claims of the present application. To begin with, all of the claims of this patent are method claims; and thus, the rejection is improper given the finding that the method claims of the present application are patentably distinct from the rejected apparatus/system claims. Furthermore, claim 1 of U.S. Patent No. 6,959,800 recites several elements that are not recited in the presently rejected claims such as

determining whether the bills meet or fail to meet a non-piece count related criterion; halting the transporting when a bill meets or fails to meet the criterion, a bill meeting or failing to meet the criterion being termed a flagged bill; wherein the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles; and wherein bills whose denomination are determined are delivered to a first set of one or more of the output receptacles and wherein bills whose denomination are not determined are directed to a second set of one or more of the output receptacles, a bill whose denomination is not determined being termed a no call bill, the output receptacles of the second set being different from the output receptacles of the first set.

Compare to, for example, withdrawn patentably distinct claims 14 and 81-86 of the present application. The other independents of U.S. Patent No. 6,959,800 appear to recite some of the same elements such as halting or stopping or presenting that are not recited in the presently rejected claims. The rejected claims of the present application also have elements that are not present in the claims of U.S. Patent No. 6,959,800 such as "substitute funds" in independent claim 1, "substitute currency media" in independent claim 11, "barcoded media" and "barcode reader" in independent claims 56 and 79, "substitute currency media," "redeemable documents," and "a second scanner capable of scanning for at least one characteristic associated with a substitute currency medium" in independent claim 87, and "redeemable documents" and "a detector ... adapted to detect ... characteristic information associated with a redeemable document" in independent claim 89.

[4] Turning to U.S. Patent No. 6,955,253, the claims of this patent differ from the rejected claims of the present application. For example, claim 1 of U.S. Patent No. 6,955,253 recites several elements that are not recited in the presently rejected claims such as

a processor programmed to determine whether the bills meet or fail to meet a non-piece count related criterion, the processor being

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programmed to cause the transport mechanism to halt in response to a determination that a bill meets or fails to meet the criterion, a bill meeting or failing to meet the criterion being termed a flagged bill, the processor being adapted to cause the transport mechanism to halt with a flagged bill being positioned as the last bill in one of the output receptacles; and

wherein bills whose denomination are determined by the discriminating unit are delivered to a first set of one or more of the output receptacles and wherein bills whose denomination are not determined by the discriminating unit are directed to a second set of one or more of the output receptacles, bills whose denomination are not determined by the discriminating unit being termed no call bills, the output receptacles of the second set being different from the output receptacles of the first set

Compare to, for example, withdrawn patentably distinct claims 14 and 81-86 of the present application: Claim 10 of U.S. Patent No. 6,955,253 recites, *inter alia*:

a processor programmed to determine whether the bills meet or fail to meet a non-piece count related criterion, the processor being programmed to cause the transport mechanism to halt in response to a determination that a bill meets or fails to meet the criterion, a bill meeting or failing to meet the criterion being termed a flagged bill, the processor being adapted to cause the transport mechanism to halt with a flagged bill being positioned as the last bill in one of the output receptacles; and

wherein a bill failing to have its denomination determined by the discriminating unit is termed a no call bill, wherein the discriminating unit is further adapted to determine whether a bill has a denomination other than a target denomination, a bill having a denomination other than the target denomination being termed a stranger bill, and wherein the device is adapted to deliver stranger bills to a first set of one or more of the output receptacles and deliver no call bills to a second set of one or more of the output receptacles, the output receptacles of the second set being different from the output receptacles of the first set.

The other independents of U.S. Patent No. 6,955,253 appear to recite some of the same elements such as halting that are not recited in the presently rejected claims. The rejected claims of the present application also have elements that are not present in the claims of U.S. Patent No. 6,955,253 such as "substitute funds" in independent claim 1, "substitute currency media" in independent claim 11, "barcoded media" and "barcode reader" in independent claims 56 and 79, "substitute currency media," "redeemable documents," and "a second scanner capable of

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scanning for at least one characteristic associated with a substitute currency medium" in independent claim 87, and "redeemable documents" and "a detector ...adapted to detect ... characteristic information associated with a redeemable document" in independent claim 89.

[5] Turning to U.S. Patent No. 6,868,954 the claims of this patent differ from the rejected claims of the present application. For example, claim 1 of U.S. Patent No. 6,868,954 recites several elements that are not recited in the presently rejected claims such as

flagging a bill when the denomination of a bill is not determined;

wherein the act of flagging comprises halting the transporting when a bill is flagged; and

delivering bills that have been denominated including bills of a plurality of denominations to a first set of one or more of the output receptacles.

Compare to, for example, withdrawn patentably distinct claims 14 and 81-86 of the present application. The other independents of U.S. Patent No. 6,868,954 appear to recite some of the same elements such as halting or stopping that are not recited in the presently rejected claims. The rejected claims of the present application also have elements that are not present in the claims of U.S. Patent No. 6,868,954 such as "substitute funds" in independent claim 1, "substitute currency media" in independent claim 11, "barcoded media" and "barcode reader" in independent claims 56 and 79, "substitute currency media," "redeemable documents," and "a second scanner capable of scanning for at least one characteristic associated with a substitute currency medium" in independent claim 87, and "redeemable documents" and "a detector ...adapted to detect ... characteristic information associated with a redeemable document" in independent claim 89.

[6] Turning to Application No. 09/684,103, claims 7-29, 78-89, and 146-149 ('103 cited claims) differ from the rejected claims of the present application. For example, claim 7 of Application No. 09/684,103 recites several elements that are not recited in the presently rejected claims such as:

a magnetic scanhead disposed adjacent to the transport path, the scanhead including an arrangement of a plurality of closely spaced

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magnetic sensors each adapted to detect the presence of a security thread within the bills, the arrangement of the plurality of closely spaced magnetic sensors being generally perpendicular to the transport direction, the scanhead being adapted to determine the location of the security thread within the bill; a memory adapted to store master security thread location information corresponding to a plurality of denominations of currency bills; and an evaluating unit adapted to determine the denomination of the currency bill when the determined security thread location favorably compares to the master security thread location information, the evaluating unit being adapted to generate an error signal when the determined security thread location does not favorably compare to master security thread location information.

Compare to, for example, withdrawn patentably distinct claims 41 and 44 of the present application. Other claims of Application No. 09/684,103 recite some of the same elements and/or additional elements that are not recited in the presently rejected claims. The rejected claims of the present application also have elements that are not present in the '103 cited claims such as "substitute funds" in independent claim 1, "substitute currency media" in independent claim 11, "barcoded media" and "barcode reader" in independent claims 56 and 79, "substitute currency media," "redeemable documents," and "a second scanner capable of scanning for at least one characteristic associated with a substitute currency medium" in independent claim 87, and "redeemable documents" and "a detector ...adapted to detect ... characteristic information associated with a redeemable document" in independent claim 89.

Thus, Applicants respectfully request the withdrawal of the obviousness-type double patenting rejections because the claims of each of the cited patents/application have elements that are not present in any of the rejected claims of the present application and/or vice versa.

#### Other Remarks

At pages 2-9 of the Office Action, sections "a"- "z" of the Office Action, there is discussion a number of limitations that are not present in the rejected claims (see, *e.g.*, "d" addressing "non-piece count related criterion"). It is also noted that many of these sections recite acts of method claims. In this regard, it is noted that method claims have been restricted out of the present application and are no longer pending. Furthermore, many of these sections refer to limitations which have been determined by the USPTO to be patentably distinct and have been withdrawn and are not present in the presently rejected set of claims (see, *e.g.*, the

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mention of halting in "e" and "f"). The Examiner has not made an effort to tie these apparently random statements to any particular claim or claim language and accordingly, Applicants will not attempt to do so in the first instance. Due to the above, the Applicants will not address these sections nor the generalized or conclusory statements herein, many of which are inconsistent with the prior findings of the patentably distinct nature of many of the claims originally contained in the present application (see, e.g., "1" and the prior restriction requirements finding embodiments containing a single output receptacle, two output receptacles, *etc.* patentably distinct and non-obvious in light of each other – see the discussion of Office Action dated December 8, 2004 and other Office Actions in the above Obviousness-Type Double Patenting section. Accordingly, the fact that we will not be addressing these claim limitations and unsupported statements does not in any manner mean that the Applicants agree with any of the assertions presented in the Office Action.

#### Conclusion

The Applicants submit that the claims are in a condition for allowance and action toward that end is earnestly solicited. No fees are believed due with this paper. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody Deposit Account No. 50-4181, Order No. 247171-000305USP1. Should there be any remaining matters, Applicants invite the Examiner to call the attorney below so that such matters may be resolved expeditiously.

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Respectfully submitted,

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